

REMARKS

This is a response to the Office Action mailed July 15, 2005, in which the Examiner:

- rejected claims 1-36 under the doctrine of double patenting; and
- rejected claims 3-6, 12-13, 15, 18-20, 23-24, 27-28, 30-31, 36 as being indefinite under 35 U.S.C. 112, second paragraph, and
- rejected claims 1-36 under 35 U.S.C. 103 as being unpatentable variously over the teachings of Vin, Baumgartner, Biswas and Marshak.

In this response, Applicants have amended the claims to overcome the Section 112 rejections and address the double patenting rejection by showing that the claims relate to separate inventions and, therefore, the double patenting rejection cannot be sustained.

Applicants then address the Section 103 obviousness rejections by demonstrating that the proposed combination of Vin and Baumgartner and/or Marshak cannot be obvious because the references are incompatible and from completely different technology areas. Furthermore, even if these references were combined, Applicants show that all the elements of the claims are not taught in any combination of the cited references.

Applicants also address two issues, raised by the Examiner in a September interview, but not raised in the Office Action, i.e. adding certain UNIX references to the prior art cited, and the contention that the claims are “conceptual.”

Additionally, Applicants have amended the claims, not in response to the prior art, but in the hope of obtaining early allowance.

Finally, and as demonstrated below, Applicants submit that the Examiner’s rejections cannot be sustained and the claims should be allowed.

EXAMINER INTERVIEW

As a preliminary matter, Applicants are grateful for the courtesy extended to their representatives, Dr. Lester F. Ludwig and Alan J. Kasper, during an interview conducted on September 22, 2005.

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At the interview the claimed invention was described and discussed as was the inapplicability of the prior art. Although no definitive agreement was reached, the meeting was very helpful.

In addition, the Examiner indicated at the interview that he was considering adding certain UNIX references (collectively “the UNIX references”) to bolster his written obviousness rejections. Although not required to do so, Applicants will address the UNIX references in this response in order to expedite allowance. In any event, should the Examiner wish to add the UNIX references to any subsequent Office Action, Applicants request that such Office Action be a non-final Office Action as the Examiner has been aware of these references for some time and comments and amendments to the claims do not raise new issues sufficient to merit a final Office Action.

Finally, the Examiner also indicated during the interview that the claims appeared to be ‘conceptual’ and that the claims require ‘more detail as to how Applicant practices the invention.’ This specific issue will be dealt with in greater detail later.

Turning now to the Office Action:

EXAMINER’S REJECTIONS

I. CLAIM REJECTIONS BASED ON DOUBLE PATENTING

The Examiner has rejected the claims based on a judicially created doctrine of double patenting as follows:

Claims 1, 14, and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,351,762 and further in view of Baumgartner et al. US patent 5,195,086.

and:

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of Application No. 10/722,051, claims 1-36 of Application 10/721,343, claims 1-42 of Application 10/721,905.

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In response to the double patenting rejection based on Baumgartner, Applicants wish to point out that independent Claims 1, and 4 have been amended by including limitations of dependent claims, thus rendering moot the double patenting rejection based on Baumgartner and US 6,351,762.

Further, claim 29, as discussed below, contains a wireless element that is neither disclosed in nor obvious from a combination of Baumgartner and the '762 patent.

In further response to the double patenting based on co-pending applications, Applicants point out that this application is one of four related applications: 10/721,385; 10/721,343; 10/721,905; and 10/722,051. Applications, 10/721,385 and 10/721,905 are a method/system pair of applications.

As shown below, the application pair and the other applications, although filed covering similar subject matter, are in fact different from each other. For example, comparing the independent claims yields the following:

Summary of the 385/905 pair's independent claims' main limitations:	Summary of the '345 application's independent claims' main limitations:	Summary of the '051 application's independent claims' main limitations:
In Claim 1, users log in to their communications devices, and service records are kept maintaining user location information. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list, and the calling user is notified if another user is not logged in..	In Claim 1 users log in to respective first and second networks using their communications devices, and service records are kept maintaining user location information no matter where the user is located. To be called users are listed in a user's quick dial list, which has been created by the calling user from a list of all potential users.	In Claim 1 users log in to their communications devices, and service records are kept maintaining user location information no matter where the user is located.. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list, and the calling user is notified if another user is not logged in.
In Claim 12 users log in to their communications devices, at least one of which is a wireless mobile phone	In Claim 14 users log in to their communications devices and service records are kept maintaining user	In Claim 14 users log in to their communications devices and service records are kept maintaining user

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<p>device, and, in so doing, at least one of the user's connects to a Wide Area communication Network. Service records are kept maintaining user location information no matter where the respective user is located.</p>	<p>location information. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list and the called user is notified of the identity of the calling user and given the opportunity to accept or reject a call.</p>	<p>location information. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list and the calling user is notified if another user is not logged in. During communication a third party can call in a be included in the communication.</p>
<p>In Claim 25 users connect to respective first and second networks using their communications devices and service records are kept maintaining user location information no matter where the respective user is located. A calling user is notified if the "being called" user is not connected to a network, and the called user is notified of the identity of the calling user and given the opportunity to accept or reject a call.</p>	<p>In Claim 29 users log in to their communications devices, at least one of which is a wireless device and service records are kept maintaining user location information no matter where the respective user is located. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list. This claim is the method equivalent of claim 29 in the '051 application.</p>	<p>In Claim 29 users log in to their communications devices, at least one of which is a wireless device and service records are kept maintaining user location information no matter where the respective user is located. A calling user selects a to-be-called user by selecting that user's icon displayed in a personalized list. This claim is the system equivalent of claim 29 in the '343 application.</p>
<p>In Claim 35 users log in to their communications devices, at least one of which is a wireless mobile phone device, and service records are kept maintaining user location information. A user selects a to-be-called user by selecting that user's icon displayed in a personalized list, and the calling user is notified if another user is not logged in. Real-time communications between the</p>		

two users includes text messaging.

II. CLAIM REJECTIONS UNDER 35 USC § 112

The Examiner has also rejected the claims under 35 USC § 112 as follows:

Claims 3-6, 12-13, 15, 18-20, 23-24, 27-28, 30-31, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “can be” renders the claim indefinite because it does not distinctly claim the subject matter. See MPEP § 2173.02.

In response, Applicants have amended the remaining ones of these claims that have not been cancelled.

III. CLAIM REJECTIONS - 35 USC § 103

The Examiner has rejected the claims under 35 U.S.C. 103 as follows:

“Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vin et al “Multimedia Conferencing in the Etherphone Environment”, and further in view of Baumgartner et al. US patent 5,195,086, Biswas “Distributed Scheduling of Meetings: A case study in Prototyping Distributed Applications” and Marshak “BeyondMail for Windows”. (All references are cited in IDS filed 12/26/03).

...

Vin teaches forwarding call to workstation where the user logged in [p.72 col.2 line 11-15]. Hence, Vin inherently has a service record containing user identification and location where each user logged in order to forward the call. Furthermore, in similar field of user collaboration, Biswas discloses the need in an active communication system to track where a user logged in so as to enable display of message on the display device that a user is currently using. See page.627 col.1 1st paragraph. Hence, it would have been obvious for one of ordinary skill in the art to have service record with user identifier and the location (i.e. the workstation) where the user logged in because it would have enabled the system to route conference calls and messages to the correct location.

...

As per claim 3, Vin and Baumgartner do not specifically disclose a wireless device. It would have been obvious for one of ordinary skill in the art to have a communication device being wireless device because it would have enabled the user to be mobile while participating in a conference.

...
As per claim 4, Baumgartner teaches the communication network is a wide area network (fig.14, 15).

...
As per claim 7, it would have been obvious in the system as modified to indicate which user is logged on and which user is not so as to enable a participant to know who is available for participating in the conference.

...
As per claims 9-10, Vin teaches automatic notifying user of attempt to communicate [page 77 col.2 ringing]. It is apparent that the system as modified would allow communication to be established with a third user.

...
As per claims 14-28, they are rejected under similar rationale as claims 1-11 above.

...
As per claims 29-36, they are rejected under similar rationale as claims 1-11 above. Vin and Baumgartner do not teach a communication device being wireless or a mobile phone. Vin teaches permit a user to participate with audio only [p.72 col.2 “Best effort conferencing ... audio only”]. Hence, it would have been obvious for one of ordinary skill in the to use a mobile phone because it would have enable a user to participate while traveling.

In summary, therefore, the Examiner relies on an inherency argument to support the contention that Vin “teaches” a service record. Vin is then combined variously with Baumgartner, Biswas and Marshak. In cases (for example, claims 3 and 7) where no reference teaches a specific element, the Examiner relies on the contention that the missing element is obvious.

IV. SUMMARY OF THE CLAIMED INVENTION & APPLICANTS' RESPONSE TO THE § 103 REJECTIONS

As explained at the interview, the claimed invention is directed to a method of real-time communication among a plurality of users. Each user has a communication device with a display and with which users can connect to at least one communication network by using or logging in at their communication devices. Connection between the users is established using service records that are maintained for the users. These service records maintain, at a minimum,

identification and locating information for each user. When a first user selects a displayed second user's identifier, the locating information and used to establish a connection, allowing communication, between the two users, displayed on the users' displays.

The inventive and very beneficial features of this invention allow a user to log-in or connect to any network, anywhere using any device and still be located by another user wishing to establish two-way communication with that user. This is clearly non-obvious, advantageous and very different from the traditional telephone model in the cited real-time communication prior art – Vin and Baumgartner – where each user has a fixed, static, hardwired address associated with an immobile/fixed physical space and device.

The question, therefore, for the Examiner is whether, in 1993, it would have been obvious to take the static hardwired, fixed-physical location systems of Vin and/or Baumgartner and change them by incorporating features of unrelated, one-way technologies to come up with the claimed invention and its commercially relevant advantages.

Despite the Examiner's reasoning in the Office Action, Applicants submit the obviousness rejections set out above cannot be sustained for a number of reasons:

- (a) It is definitely not inherent in Vin to have a service record, on this point alone, the rejection of all the claims must fail.
- (b) Moreover, the references are incompatible and improperly combined, thus the Examiner cannot meet the burden of proof required to establish a *prima facie* case of non-obviousness.
- (c) Furthermore, it is improper and in this case not obvious to merely add features not taught by any reference.
- (d) Finally, at least one element the Examiner deems taught by a reference is not. Each of these points is addressed separately below.

V. APPLICANTS' RESPONSE TO THE § 103 REJECTIONS

Applicants submit these rejections cannot be sustained for a number of reasons:

- (a) It is definitely not inherent in Vin to have a service record, on this point alone, the rejection of all the claims must fail.
- (b) Moreover, the references are incompatible and improperly combined, thus the Examiner cannot meet the burden of proof required to establish a prima facie case of non-obviousness.
- (c) Furthermore, it is improper and in this case not obvious to merely add features not taught by any reference.
- (d) Finally, at least one element the Examiner deems taught by a reference is not.

Each of these points is addressed separately below:

A. SERVICE RECORD IS NOT INHERENT IN VIN

The key reference in the Examiner's rejection of the claims is Vin and the Examiner's key contention is that the claimed service record, although not disclosed, is inherent in the Vin reference. But, as shown here, the claimed service record is not and cannot be inherent in Vin.

The law related to "inherency" places a very specific burden on its proof. Specifically, in "relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. . ."¹ *(citations omitted, emphasis added.)*

In addition, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . . To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

¹ MPEP § 2112(IV), p 2100-55, Rev. 2, May 2004.

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possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ . . .’² (*citations omitted, emphasis added.*)

Furthermore, “. . . [s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”³ (*citations omitted.*)

It is respectfully submitted that these requirements have not and cannot be met. Specifically, the Examiner cannot rely on Vin’s “call forwarding” feature to support the notion that a service record is inherent. Vin may state, at page 72, that “call forwarding automatically forwards calls to the workstation where a user is logged in.” But, this one-line statement does not teach or make inherent the claimed service records that includes both user identification and location information.

The reason for this is simple. The claimed service record is not inherent (i.e., “necessarily present”) in Vin because there are many ways in which “call forwarding” can be implemented where the claimed service record is not necessarily present.

For example, today’s rich-feature, two-line telephone can, upon receiving an incoming call, automatically dial a forwarding number and internally connect the two lines together. This does not necessarily require the use of the claimed service record.

Further, the common definition of call forwarding in the art, as supported by the references below, precludes the interpretation embraced by the Examiner. Specifically, consultation of “OneLook” (www.onelook.com), a comprehensive on-line multiple source compendium of term definitions, categorically maintains that “call forwarding” does not necessarily require the user identification and location information:

“A telephone service that enables a customer to have an incoming call automatically rerouted to another extension.” (The American Heritage® Dictionary of the English Language: Fourth Edition, 2000.
<http://www.bartleby.com/61/89/C0038975.html>)

² MPEP § 2112(IV), p 2100-54-55, Rev. 2, May 2004.

³ MPEP § 2131.01(III), p. 2100-74, Rev. 2, May 2004.

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“A telephone service feature whereby, when a customer chooses, all calls coming in to one number are automatically rerouted to another, designated number.” (Infoplease Dictionary,
<http://www.infoplease.com/dictionary/call+forwarding>)

“A service that allows one to transfer one's incoming calls to any other telephone number.” (UltraLingua English Dictionary,
<http://www.ultralingua.net/index.html?service=ee&text=call+forwarding>)

“Lets you transfer your incoming calls to any telephone that you can dial direct (WordNet ® 2.0, © 2003 Princeton University,
<http://dictionary.reference.com/search?r=66&q=call%20forwarding>)

“Call forwarding (or call diverting), in telephony, is a feature on some telephone networks that allow an incoming call to a called party which would be otherwise unavailable to be redirected to a mobile telephone or other telephone number where the desired called party is situated. Usually, the forwarded line rings once, to remind anyone there that calls are being redirected.” (Wikipedia,
http://en.wikipedia.org/wiki/Call_forwarding)

It is clear, therefore, from these definitions that call forwarding, at least in those circumstances, requires a user to re-route calls subsequently direct to that user. To do so, the user must take the active and additional step of providing the new location number. Thus, the claimed service record with user location and identification are not required. Thus, it is submitted, therefore, that Vin does not render inherent the claimed service records and on this ground alone, the obviousness rejection must fail.

B. THE CITED SERVICE REFERENCES ARE INCOMPATIBLE AND A PRIMA FACIE OBVIOUSNESS CASE CANNOT BE ESTABLISHED

In the Office Action, the Examiner argues that the claims would be obvious based variously on a combination of primary reference Vin with the teachings of two or more of Biswas, Baumgartner, and Marshak.

But, as explained below, it is improper to make such combinations because Bisaws and Marshak are totally incompatible with Vin and/or Baumgartner. Thus the Examiner cannot show the mandated tests for obviousness, specifically:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143

Combining Vin and Biswas is not possible, let alone, obvious

The Examiner looks to Biswas to support his conclusion that Vin would necessarily need to track where a user is logged in. But, in doing so, the Examiner is suggesting a combination of features from two totally unrelated and incompatible pieces of prior art. This is impermissible in obviousness rejections.

Biswas is unrelated to and incompatible with Vin for three reasons: Biswas is (a) a non-real time system; (b) a calendaring and meeting scheduling system that automatically generates non-real time communications to schedule meetings on behalf of users by attaining an active “consensus” among the users of the system; and (c) a one-way messaging system.

This is absolutely clear from phrases like “People asynchronously reply to the meeting scheduling request...”⁴ and “Asynchronous operation,...were some of the important design goals.”⁵ Furthermore, Biswas’ non-real time calendaring system, at best, only allows for non-real time, one-way messages about calendaring.

In sharp contrast, Vin is a (a) real-time; (b) video conferencing; and (c) two-way system. There cannot be any and therefore is no suggestion at all in either of Vin or Biswas that it would be desirable to combine them as suggested by the Examiner.

Without such suggestion, any obviousness argument runs afoul of the rule, that “the prior art must suggest the desirability of the claimed invention” and that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

⁴ Page 656, Abstract, Second paragraph.

⁵ Page 656, Section 1.2, First paragraph.

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invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.”⁶ (emphasis added.)

Thus, Applicants strongly submit that the Examiner has not demonstrated, how or why someone using Vin’s two-way, real-time, video conferencing system would look to a one-way, non-real time, calendaring system to solve a problem that is not even identified by Vin.

In this regard, it is important to note that it is well established that the mere “fact that references can be combined or modified is not sufficient to establish prima facie obviousness”⁷ and that the mere “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness.”⁸

For several reasons therefore, there can be no motivation to combine the teachings of Vin and Biswas. Such an attempt to combine would begin with hindsight, take bits and pieces of incompatible references, and merge these incompletely in a direction contrary to the express teachings of the applications of the references.

Now, the Examiner may point out that Biswas suggests a user must be tracked so that information is presented to the appropriate display device that the user is currently using. Even so, there is no teaching or suggestion that a “service record,” as defined in the present claims, must be established and maintained for users on the basis of a user identity and the location where a user is logged in to provide such tracking. Additionally, there is no teaching or suggestion that the claimed “service record” is used to establish a two-way communication on the basis of such service record.

Thus, even in the totally non-obvious situation where Biswas and Vin are combined or combinable, not all the elements of the claimed service record would be present. Absence of all

⁶ MPEP § 2143.01 paragraph I.

⁷ MPEP 2143.01, paragraph III. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).”

⁸ MPEP 2143.01, paragraph IV.

elements precludes an obviousness rejection because of the fundamental requirement that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”⁹

Combining Vin and Marshak is similarly not possible, let alone, obvious

Combining the incompatible combination of Vin and Biswas with incompatible Marshak to create a personalized directory is, for similar reasons as stated above, not possible, let alone obvious. In this regard, the Examiner is reminded that a mere force fit of incompatible references runs afoul of the well established rules that “any proposed modification cannot render the prior art unsatisfactory for its intended purpose”¹⁰ and that “any proposed modification cannot change the principle of operation of a reference.”¹¹

C. IT IS NOT PROPER MERELY TO ASSERT A CLAIMED FEATURE IS OBVIOUS WITHOUT POINTING TO A REFERENCE

In at least two situations the Examiner contends that certain claimed features are merely obvious despite the fact that no cited references include or remotely hint at these features. Despite the Examiners’ contention, these features are definitely inventive, as is shown below.

Log-in or Connection “Presence” Indication

The Examiner has rejected claims that “indicate whether a user is logged in” by dismissing this feature as “...obvious in the system as modified to indicate which user is logged on and which user is not so as to enable a participant to know who is available for participating in the conference.”

⁹ MPEP §2143.03.

¹⁰ MPEP 2143.01 paragraph V. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

¹¹ MPEP 2143.01 paragraph VI. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

Apart from not meeting all the requirements for proving obviousness discussed above, Applicants wish to point out that this feature, which was invented at least as early as 1993, has demonstrable value as it is only now that companies as innovative as AOL, Microsoft, Yahoo!, Reuters, and others are relying on this feature as being important in their newest products.

As an illustration of this non-obviousness Applicants submit copies of four articles¹² from recent publications that demonstrate the commercial importance of this feature, called ‘presence’ indication in the articles. For example, the Financial Times article notes “This ‘presence’ information will form a keystone for the next generation of desktop software and communications applications” and that “Microsoft is betting heavily on both presence and real-time communications for the next version of its Office suite (Office 12), as well as for enhancements that it will build into the next version of Windows, known as Vista.”

This is clear evidence of commercial success/importance of the “presence notification” feature and, it is submitted, evidence of non-obviousness. Accordingly, it is submitted that this obviousness rejection should be withdrawn.

This feature is found in claims 1, 14, and 32.

Wireless Limitations

The Examiner has admitted that none of the cited art teaches or even hints at wireless communication and, necessarily, concedes that all devices are hard wired to the local network. The adaptation of a hardwired system to accommodate a wireless device, as claimed, would have to consider the further limitations in the claimed method of allocating to each participant a unique identification information and maintaining service records having information associated with where a user is connected to the network. The manner in which such information would be

¹² “FT Report – Digital Business” Financial Times, October 5, 2005, p. 6.;

“SiteScrape Rolls Out Forum ZX for Integrated Collaboration; Merges presence detection, instant messaging and web/audio conferencing with traditional collaboration tools” TMCnet News, November 2, 2005, www.tmcnet.com;

“Akonix Security Center Publishes IM/P2P Threat Watch for October 2005; Monthly Report Highlights Increase in P2P Security Attacks From September to October” Business Wire, October 31, 2005, www.businesswire.com;

“Killer app for IBM Workplace may be multi-enterprise collaboration” SearchDomino.com, November 4, 2005, www.searchdomino.com.

maintained for a wireless system, which itself may be transportable, presents issues that are not addressed by a simple decision to “make it wireless,” as the Examiner appears to suggest.

Accordingly, it is submitted that this obviousness rejection should be withdrawn.

This wireless feature is found in claims 3, 19 and 29.

D. AT LEAST ONE ELEMENT THE EXAMINER DEEMS TAUGHT IS NOT TAUGHT AT ALL

In addition to the arguments above, the Examiner cites Baumgartner, specifically Figs. 14 and 15, as teaching a Wide Area Network (WAN). But, careful study of this reference reveals that neither figure shows WAN communication. Instead, both relate to the communication between two parties via a virtual circuit, defined as a packet-switched communication path between two endpoints, that permits two parties to share a character based application program or applications based the X-window system. There is no teaching or suggestion of a connection between communication devices via WAN or plural networks.

Moreover, the application of a WAN is itself novel and unobvious. The user tracking techniques employed by the present invention, as defined in, for example, claim 1 involves the use of service records for at least first and second users. These service records provide a mapping capability for users. Where a WAN is employed to couple users whether through a LAN or directly, the service records enable communication in a manner not taught anywhere in the prior art. The complex addressing and address translation schemes that would be involved, for example, in a given terminal at a first LAN to address a second terminal at a remote LAN via a WAN network, extends far beyond the primitive teachings of any of the four references.

This feature is claimed in claims 4 and 20.

VI. THE UNIX REFERENCES, MENTIONED BY THE EXAMINER IN THE INTERVIEW, DO NOT CORRECT THESE DEFICIENCIES

The Examiner, in the interview, appeared sympathetic to Applicants’ point of view that no service record was taught by the references, but then suggested that other references could be combined with Vin to teach the service record. Specifically, the Examiner cited the UNIX 4th Berkeley Release 1991 main pages for ‘login’, ‘utmp’, ‘talk’, and ‘who.’

But, should the Examiner use this reference, it will be impossible to show obviousness because of nonsensical results.

Specifically, the UNIX cited functions can only be used within separate ‘dumb ASCII terminal’ sessions within a single common computer, i.e. they are internal, single-computer, shared-operating-system functions. But, the Vin system uses separate standalone networked computer workstations, each in which a separate instance of the UNIX system runs. In this adaptation of UNIX from multi-user shared operating system computer environment to single user workstation, the UNIX multi-user capabilities are transformed into single-user multi-task capabilities. The workstation CPU acts as the host, but terminal emulator windows (‘xterm’) on the workstation screen act as the dumb ASCII terminals. As a result, if the UNIX functions cited by the Examiner were combined with the Vin system, they would be implemented on the Vin workstations. Each workstation would run as an isolated separate host computer operated only by one user, and additionally, if one were to make this combination, the cited UNIX functions would pertain only to the separate dumb terminal emulation windows that appear as windows on the same screen of the same machine. The cited UNIX functions could not capture any information as to users logged in on the other workstations. A Vin plus UNIX combination would, therefore, be absolutely useless and indeed fail for Vin’s intended purpose. Thus, the cited UNIX functions plus Vin combination cannot be used to argue the claims are obvious.

The remote versions of the UNIX functions (for example, rwho) also fail to teach, suggest or render obvious the invention as claimed.

VII. ADDRESSING THE EXAMINER’S CONTENTION THAT THE CLAIMS ARE CONCEPTUAL

The Examiner has indicated that he felt the claims were “conceptual.” In response, Applicants initially wish to point out the fact that the claims include numerous physical limitations such as networks, displays, user-interface features, very specific enabling technology, for example, the use of a service record for the tracking of a user, all of which, when combined, lead to very specifically claimed results.

Equally important, the question whether claims are conceptual is not a ground for rejecting the claims. Specifically, the notion that claims require structure, instead of being conceptual, and must fall within the “technological arts” was specifically rejected by the Board of Patent Appeals and Interferences in the recent ruling in Ex parte Carl A. Lundgren, Appeal No. 2003-2088.

In particular, the Board ruled “our determination is that there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter . . . we decline to propose to create one. Therefore, it is apparent that the Examiner’s rejection cannot be sustained.”

Accordingly, the Examiner cannot rely on an improper technological art or “too conceptual” ground for rejecting the claims.

In any event, as pointed out above and is evident from reading the claims, these patents relate very specifically to the technological arts, in particular the methods and systems for real-time communications between the various parties and not conceptual at all.

CONCLUSION

In summary, all the claims contain at least a limitation to a service record, which is neither taught by, inherent in nor obvious from Vin alone or in combination with the cited prior art. Moreover, Applicants have shown that such combination of references is not possible because of major incompatibilities and therefore cannot be obvious. Finally, as shown above, certain other claimed features are not present in the references.

Applicants accordingly respectfully submit that all of the original claims, and all of the claims as now amended, define subject matter that is patentable over the prior art. Applicants emphasize that amendments to the claims are made to obtain allowance and not because Applicants accept the section 103 rejections are proper. Their immediate allowance is respectfully requested as soon as possible.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Alan J. Kasper/

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